



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/665,526	09/19/2000	Steven G. LeMay	IGT1P018	5846

22434 7590 09/25/2002

BEYER WEAVER & THOMAS LLP
P.O. BOX 778
BERKELEY, CA 94704-0778

EXAMINER

COBURN, CORBETT B

ART UNIT	PAPER NUMBER
----------	--------------

3714

DATE MAILED: 09/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/665,526

Applicant(s)

LEMAY ET AL.

Examiner

Corbett B. Coburn

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-29 and 38-40 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 30-37 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449), Paper No(s) 2,3,4, 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: System And Method For Providing Entertainment Such As Music, Video, Or Internet Access To A Gaming Machine Player

Drawings

3. The drawings are objected to because of the issues noted on the attached Notice of Draftsperson's Patent Drawing Review. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Election/Restrictions

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-29 & 38-40, drawn to method and apparatus for providing entertainment to a gaming machine player, classified in class 463, subclass 20.

Art Unit: 3714

- II. Claims 30-37, drawn to method for providing messages to a slot machine player, classified in class 463, subclass 25.

The inventions are distinct, each from the other because of the following reasons:

5. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as providing a paging system for slot machine players. See MPEP § 806.05(d).

6. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with David Olynick on 16 September 2002 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-29 & 38-40. Affirmation of this election must be made by applicant in replying to this Office action. Claims 30-37 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 20 recites the limitation "the required indicia of credit amount" in lines 5 & 6-7. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 3714

10. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 21 recites the limitation "the required indicia of credit amount" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. (Examiner assumes that claim 21 should depend from claim 20.)

11. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what "loading information enabling the entertainment content to the entertainment content sources" means. Something appears to be missing. While the specification (page 4, 21-23) contains the same language, Examiner admits that the phrase is bewildering. There are two interpretations that the Examiner can put on the phrase. First, the phrase may mean loading information that says whether the player may have access to the entertainment content. The other interpretation is loading information needed to enable access (passwords, addresses, etc.) to the entertainment content.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Art Unit: 3714

13. Claims 1, 2, 6, 7, 17, 38-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Fey (*Slot Machines*, 1983, Liberty Belle Books).

Claims 1, 38: On pages 158 & 159, Fey teaches a number of gaming devices with music. The 1899 Musical Puck inherently contains a master game controller that controls a game played on the gaming machine and displayed on the display device – the large central wheel. Fey discloses that a winner received a music check each good for one tune (see token below machine). While not explicitly described in the text, this token must inherently be input through an input device. There is an output device (the music box) configured to output entertainment from the selected entertainment content source. The entertainment content is independent of the game outcome presentation presented on the gaming machine. The entertainment content is provided during selected operational modes of the gaming machine – i.e., when the player inputs a music check.

Claim 2: The output device includes a sound projection device.

Claims 6, 39: The entertainment content is a musical selection.

Claim 7: The game is a mechanical slot game.

Claim 17: The input device is used to control a feature of the entertainment content – i.e., when the entertainment content starts.

Claim 40: The Musical Puck machine provides one or more predetermined conditions that a player must satisfy in order to access the entertainment content of the gaming machine – the player must win a music check. When the player wins a music check (satisfies the condition), the entertainment content is output to an output device – the

Art Unit: 3714

music is played. The music played is independent of the game outcome presentation (spinning the wheel) of the game.

14. Claims 1-8, 10-16, 22, 23, 25, 26, 28, 29, & 38-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al (US Patent Number 6,113,495).

Claims 1, 38: Walker teaches a gaming machine with a display device (reels 332, 334, & 336); a master game controller (310) that controls one or more games played on the gaming machine and presents a game outcome presentation (images) the display device (reels 332, 334, & 336). There is an input device (370) for selecting an entertainment source (Abstract). Video display area (346) is an output device configured to output entertainment during selected operational modes of the gaming machine. The entertainment content is independent of the outcome presentation presented on the gaming machines.

Claim 2: The output device is a monitor.

Claim 3: The entertainment content source is a server. (110)

Claim 4: The media software application is a web browser. (Col 5, 54-60)

Claim 5: The input device (370) is a touch screen. (Col 7, 29-31)

Claims 6, 28, 39: The entertainment content may include a web page. (Col 5, 44-60)

Claims 7, 29: The game may be a video slot game. (Abstract)

Claim 8: There is a first communication interface (Fig 2, 265) that allows the gaming machine to communicate with an entertainment source outside of the gaming machine.

Claim 10: The entertainments content is initiated when game play is initiated on the gaming machine. (Fig 8)

Art Unit: 3714

Claim 11: Access to the entertainment content is time dependent on an indicia of credit amount, wager amount, or game playing history. (Col 9, 48- Col 10, 4)

Claim 12: The information content is provided according to a player information profile. (Col 10, 17-24)

Claim 13: Fig 3 shows communication through a second communication interface with an output device (Display 362) located outside of the gaming machine.

Claim 14: Figure 1 clearly shows the gaming machine (300) connected to an entertainment service network.

Claims 15, 26: Walker teaches that the game outcome presentation may be displayed on the display device while the entertainment content is displayed on the display device. (Col 7, 62 – Col 8, 9)) This means that the output device and the display device are the same.

Claims 16, 25: The entertainment content may be displayed on the output device (346) while the game outcome is displayed on the display device (332, 334, 336). (Col 7, 4-8 & 57-61)

Claim 18: Walker discloses an entertainment content source providing entertainment content independent of a game outcome presentation presented on a gaming machine.

(Abstract) The entertainment source is adapted for operation only during selected operational modes of the gaming machine – when casino specified criteria are met. (Fig 7A, 715) The entertainment source is a server. (Fig 1, 110)

Claim 19: Walker teaches displaying a list of one or more entertainment sources. (Fig 8, 830) The system receives a selection from the list. (840) The entertainment content is

Art Unit: 3714

output to the display. (850) The entertainment content is independent of the game outcome presentation.

Claim 22: Walker teaches receiving player-tracking information (Fig 4) prior to receiving the selection and allowing access to the entertainment content sources based on the player tracking information. (Col 9, 48-66)

Claim 23: Walker teaches allowing a player to buy access to entertainment content sources for a period of time; comparing the access time to the total time bought; and terminating access to the entertainment content source when the access time exceeds the total time. (Figs 7B & C)

Claim 40: Walker provides one or more predetermined conditions that a player must satisfy in order to access the entertainment content of the gaming machine. (Col 2, 39-60) When the player satisfies the condition, the entertainment content is output to an output device. (Fig 7A) The entertainment content is independent of the game outcome presentation (spinning the reels) of the game.

15. Claim 24 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Walker as applied to Claim 19.

Claim 24 (102 version): Walker teaches downloading information concerning whether the player has access to the entertainment content prior to displaying the menu of entertainment choices. (Fig 7A, 715 & Col 2, 41-60)

Claim 24 (103 version): Walker teaches the invention substantially as claimed. Walker, however, teaches loading information (passwords, addresses, etc.) enabling access to the entertainment content on the entertainment source (Fig 7A, 730) after the list of

Art Unit: 3714

entertainment content sources is displayed. Loading the database before the player chooses the menu selection will provide a quicker response to the player's input. It would have been obvious to one of ordinary skill in the art at the time of the invention to have loaded the information enabling access to the entertainment content on the entertainment source prior to displaying the list of entertainment content sources in order to provide a quicker response to the player's input.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker as applied to claim 8 above in view of Dabrowski (US Patent Number 6,379,246).

Claim 9: Walker teaches the invention substantially as claimed, but fails to teach interposing a firewall between the gaming machine and the Internet. It is extremely well known that a firewall helps provide security, thus helping to prevent hackers gaining access to a system. Hackers can cause damage in a number of ways. They may, for instance, cause a computer system to shut down. This would cost a casino money because a slot machine that is down cannot be played. Hackers may even access accounting data, stealing from the casino or from players. This would be a public relations disaster. Dabrowski, an invention in the same field of endeavor, teaches using a firewall to provide protection. (Col 3, 60-62) It would have been obvious to one of

Art Unit: 3714

ordinary skill in the art at the time of the invention to have used a firewall to limit access to the gaming machine via the first communications interface in order to protect the casino from hackers.

18. Claims 17, 20, 21 & 27 rejected under 35 U.S.C. 103(a) as being unpatentable over Walker as applied to claim 1 or 19.

Claim 17, 27: Walker teaches the invention substantially as claimed. Walker teaches interactive entertainment content – web pages (Col 5, 44-60) The player must provide some input through an input device in order to browse a web page. Walker does not specifically disclose how this is accomplished. It would have been obvious to one of ordinary skill in the art at the time of the invention to have the input device be used to provide a second input signal to control a feature of the entertainment content in order to allow the player to browse a web site.

Claim 20: Walker teaches the invention substantially as claimed. Walker teaches determining an indicia of credit amount for the selected entertainment content prior to outputting entertainment content. (Col 9, 64-66) Walker teaches displaying a message on the display device notifying the player of the required indicia of credit amount. (Col 11, 24-34) Walker teaches initiating the selected entertainment content when the required indicia of credit amount is available on the gaming machine. (Col 10, 13-24) Walker does not specifically teach displaying the message prior to providing the entertainment content. Without such a message, the player would not know how to gain access to the entertainment content. It would have been obvious to one of ordinary skill in the art at the time of the invention to have displayed a message on the display device

Art Unit: 3714

notifying the player of the required indicia of credit amount prior to granting access to the entertainment content in order to inform the player how to gain access to the entertainment content.

Claim 20: Walker makes it clear that the required indicia of credit amount is independent of the wager on the game. (Col 9, 48-66)

Double Patenting

19. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

20. Claims 1-7, 11, 16, 18, 19, 25, 28, 29 & 38-40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 7-9, 11-13 & 15 of U.S. Patent No. 6,302,790. Although the conflicting claims are not identical, they are not patentably distinct from each other because in both cases, entertainment content is provided to the player of a gaming machine independent from the display of the game outcome.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 3714

Reference Name	US Patent Number	Applicability
Pascal et al.	5,971,851	Provides entertainment to players
Marnell, II	5,259,613	Provides entertainment to players

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



cbc

September 16, 2002



JESSICA HARRISON
PRIMARY EXAMINER